

REMARKS

Claims 6-9 were pending in this case, and will remain pending upon entry of this Amendment.

Claim 6 stands rejected under 35 U.S.C. Section 102(f) on the basis that applicant did not invent the claimed subject matter. The Office Action cites U.S. Patent Nos. 6,624,183, 6,297,236 and 6,620,822 as disclosing the combination of prothioconazole with at least one other fungicidal compound. The office action alleges that each of said patents have a different inventive entity, and concludes that as such it appears that applicant did not invent the claimed subject matter.

First, applicants point out that those three patents and the current application and the current application's parent application which issued as U.S. Patent No. 6,306,850 are all commonly assigned to Bayer AG. It is believed that 35 U.S.C. Section 103 (c) precludes a rejection under Section 102(f) in this case.

Also, the present application claims priority back to German Patent Application No. 197 16 257.6 filed April 18, 1997 and therefore predates any of the three patents. Applicants offer to provide a certified English translation of the priority document if the above discussion of 35 U.S.C. Section 103(c) was deemed insufficient by the Examiner to result in withdrawal of the rejection. Applicants respectfully request that the Examiner telephone the undersigned before issuing the next Office Action to provide the undersigned with an opportunity to provide the translation.

Claims 6-9 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the allegedly acknowledged prior art in view of U.S. Patent No. 3,903,090. The Office Action acknowledges that the reference does not disclose the combination of prothioconazole with other fungicides, but argues that the compounds claimed in combination with it in the present application are known fungicides, and that it would be obvious to combine known fungicides.

Where an Office Action raises an obviousness rejection over a single reference, as opposed to over the combination of two or more references, clearly the Examiner must be alleging that one skilled in the art reading the single reference would find the present invention obvious. That necessarily requires that the Examiner is concluding what one skilled in the art would know or would not know.

Clearly, there is no such teaching, suggestion or motivation shown in the reference in this case for the combination of the present invention. The Examiner has merely referred to a broad statement at column 32, line 39 that fungicide of US 3,903,090 could be combined with other fungicides. There is no discussion of what fungicides, nor any discussion how to identify which would provide the synergistic effects obtained with the claimed combinations of the present invention.

If the Examiner is relying on knowledge generally available to one of ordinary skill in the art to guide one using only the single reference, MPEP Section 2144.03 states that if Applicant traverses such an assertion, and Applicants do in this case, the Examiner should cite a reference in support of his or her position. Applicants hereby request such a reference. If the Examiner is relying on facts within his personal knowledge, Applicants respectfully request and are calling for, pursuant to MPEP Section 2144.03 and 37 C.F.R. Section 104, that the Examiner support such facts by an Affidavit. In short, what motivates one skilled in the art to combine prothioconazole with the compounds of the present invention to obtain the fungicidal composition of the present invention.

Applicants' respectfully caution the Examiner about making conclusory statements not supported by objective evidence. As set forth in the case of *In re Lee*, 61 USPQ2d 1430 (CAFC January 18, 2002):

As applied to the determination of patentability *vel non* when the issue is obviousness, "it is fundamental that rejections under 35 U.S.C. §103 **must be based on evidence** comprehended by the language of that section." *In re Grasselli*, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983). The essential factual evidence on the issue of obviousness is set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. *See, e.g., McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the *Graham* factors).

"The factual inquiry whether to combine references must be thorough and searching." *Id.* **It must be based on objective evidence of record.** This precedent has been reinforced in myriad decisions, and cannot be dispensed with. *See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'" (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340,

1352, 48 USPQ2d 1225, 1232(Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617(Fed. Cir. 1999) (**“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”**); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637(Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600(Fed. Cir. 1988) (“teachings of references can be combined *only* if there is some suggestion or incentive to do so.”) (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933(Fed. Cir. 1984)).

The need for specificity pervades this authority. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317(Fed. Cir. 2000) (**“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”**); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459(Fed. Cir. 1998) (“even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination.

In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.”); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783(Fed. Cir. 1992) (**(the examiner can satisfy the burden of showing obviousness of the combination “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references”**).

[2] With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. **The examiner's conclusory statements** that “the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software” and that “another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial” **do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to “[use] that which the inventor taught against its teacher.”** *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPO 303, 312-13 (Fed. Cir. 1983). **Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.**

....

Conclusory statements such as those here provided do not fulfill the agency's obligation. This court explained in *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697, that **“deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is ‘basic knowledge’ or ‘common sense.’”** The Board's findings must extend to all material facts and must be documented on the record, lest the “haze of so-called expertise” acquire insulation from accountability. “Common knowledge and common sense,” even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority.

....

The determination of patentability on the ground of unobviousness is ultimately one of judgment. In furtherance of the judgmental process, the patent examination procedure serves both to find, and to place on the official record, that which has been considered with respect to patentability. The patent examiner and the Board are deemed to have experience in the field of the invention; however, this experience, insofar as applied to the determination of patentability, must be applied from the viewpoint of “the person having ordinary skill in the art to which said subject matter pertains,” the words of section 103. In finding the relevant facts, in assessing the significance of the prior art, and in making the ultimate determination of the issue of obviousness, the examiner and the Board are presumed to act from this viewpoint. **Thus when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record.** The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

Emphasis Added.

Thus, Applicants respectfully request the Examiner explain with greater clarity what about the US 3,903,090 reference motivates one skilled in the art to combine prothioconazole with the compounds of the present invention to obtain the fungicidal composition of the present invention.

The Examiner's attention is respectfully directed to the examples in the present application (while the results are not in the form of a declaration, Applicants will put them in such form if the Examiner deems such to be necessary). Specifically the efficacy of each component alone has been compared to the combination claimed and reported in the Examples. In each instance the claimed compounds exhibited a synergy which could not have been predicted from results obtained using each individual component alone. Clearly the reference does not fairly suggest the claimed invention of the present application.

Applicants respectfully assert that this was recognized in the parent application which issued on one of the combinations as U.S. Patent No. 6,306,850.

Claims 6-9 stand rejected under 35 U.S.C. Section 103(a) over WO 96/126048. The Office Action argues that it discloses the combination of prothioconazole with other fungicides to widen the spectrum of action, to prevent build of resistance and that the activity of the mixture in many cases exhibits synergistic activity.

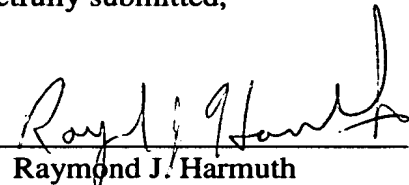
Applicants believe the Examiner meant WO 96/16048, not WO 96/126048 and will proceed accordingly, but the Examiner is requested to advise Applicants if this is not the case.

Applicants reassert all of the arguments asserted above against US 3,903,090 here. If this is deemed insufficient to overcome the rejection, Applicants offer to provide a certified English language translation of the priority document to overcome the rejection and request that the Examiner contact the undersigned to do so before issuing the next Office Action in the case.

Applicants believe the foregoing comments are sufficient to overcome the rejections. Review and consideration of the claims and allowance of the same are respectfully requested.

Respectfully submitted,

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